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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,812	08/05/2003	Martin L. Hage	10-9410	8827

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EXAMINER

SHOSHO, CALLIE E

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/635,812

Applicant(s)

HAGE, MARTIN L.

Examiner

Callie E. Shosho

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/23/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 3-4, 6, and 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claim 3 recites an improper Markush group. In line 2, after “from” and before “group”, it is suggested that “a” is changed to “the”.

Similar suggestions are made with respect to claim 4, line 2, claim 9, line 2, and claim 10, line 2 which each also recite improper Markush group similar to claim 3.

(b) Claim 6 recites an improper Markush group. In line 2, after “from” and before “group”, it is suggested that “a” is changed to “the” and in line 3, after “lithium” and before “mixtures”, it is suggested that “or” is changed to “and”.

Similar suggestions are made with respect to claim 8 that also recites improper Markush group similar to claim 6.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 61-017101.

Pending translation, it is noted that JP 61-017101 discloses ophthalmic marking ink comprising 1-10 parts water and 1 parts dye. Thus, it is calculated that the ink comprises 50-99% water and 1-50% dye. Further, there is disclosed ophthalmic lens marked with the ink (abstract).

In light of the above, it is clear that JP 61-017101 anticipates the present claims.

5. Claims 1 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 60-023092.

Pending translation, it is noted that JP 60-023092 discloses ink for plastic lens for optical glasses comprising dye and water. The ink comprises 0.1-10% dye and thus, 90-99.9% water. Further, there is disclosed lens marked with the ink (abstract).

In light of the above, it is clear that JP 60-023092 anticipates the present claims.

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6. Claims 1, 10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 472496.

EP 472496 discloses ink for marking contact lens wherein the ink comprises dye including anthraquinone dye (Vat Blue 6) and water. Example 3 discloses ink comprising 62% water and 9% dye. Further, there is disclosed contact lens marked with the above ink (col.2, lines 32-48, col.3, line 19-col.4, line 5, and col.4, lines 24-28).

In light of the above, it is clear that EP 472496 anticipates the present claims.

7. Claims 1, 10, and 13-16 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 08-112566.

Using English translation of the reference provided by applicants, it is noted that JP 08-112566 discloses ink for contact lens wherein the ink comprises 0.01-20% dye including anthraquinone dye (Vat Blue 6), 0.001-5% surfactant, 1% sodium hydroxide, polyvinyl pyrrolidone, i.e. binder, coupling tail solvent such as glycerin, and water. Example 1 discloses ink comprising approximately 1.8% glycerin and 0.4% surfactant. Further, there is disclosed contact lens marked with the ink (claim 1 and paragraphs 9, 16-20, 22, and 24).

In light of the above, it is clear that JP 08-112566 anticipates the present claims.

8. Claims 1, 10, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Su et al. (U.S. 5,352,245).

Su et al. disclose ink for contact lens wherein the ink comprises 0.5-15% dye including anthraquinone dye (Remazol Brilliant Blue R), 0.01-2% nonionic surfactant, 5-30% polyvinyl

pyrrolidone i.e. binder, 10-40% isopropyl alcohol, and remainder water. Further, there is disclosed contact lens marked with the ink (col.1, lines 51-64 and col.2, lines 36-52 and 55-56).

In light of the above, it is clear that Su et al. anticipate the resent claims.

9. Claims 1, 9-10, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Doshi '410 (U.S. 6,315,410).

Doshi '410 disclose ink for contact lens wherein the ink comprises 0.1-15% dye and pigment wherein the dye includes anthraquinone (Reactive Blue 4) or azo (Reactive Yellow 86) dyes and the pigment includes titanium dioxide, 30-60% water, 0-50% polymer, 0-2% coupling tail solvent, i.e. ethylene glycol, and 0-10% nonionic surfactant. Further, there is disclosed contact lens marked with the ink (col.3, lines 45-49, col.5, lines 18-20, 36-51, and 55-58, col.7, lines 66-67, col.8, lines 43-48, col.11, line 67-col.12, line 9, col.12, lines 25-27, col.13, lines 26-29 and 35-45, and col.26, lines 8-33).

In light of the above, it is clear that Doshi '410 anticipate the present claims.

10. Claims 1 and 9-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Doshi et al. '676 (U.S. 2004/0130676).

Doshi 'et al. 676 disclose ink for contact lens wherein the ink comprises 0.1-15% dye and pigment wherein the dye includes anthraquinone (Reactive Blue 4) or azo (Reactive Yellow 86) dyes and the pigment includes titanium dioxide, 30-60% water, 0-50% polymer, 0-2% coupling tail solvent, i.e. ethylene glycol, and 0-10% nonionic surfactant. Further, there is disclosed contact lens marked with the ink. There is also disclosed method of applying the ink to the

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contract lens wherein the lens is pre-treated by cleaning and corona treatment followed by pad printing the ink onto the contact lens (paragraphs 2, 26, 44, 48-49, 92, 132-133, 139-140, 147, 228, and 231).

In light of the above, it is clear that Doshi et al. '676 anticipate the present claims.

11. Claims 1, 10, and 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Tucker et al. (U.S. 2003/0119943).

Tucker et al. disclose ink for marking contact lens wherein the ink comprises 60-99% water, 0-15% colorant including dyes, 1-30% binder, 0.2-0.5% nonionic surfactant including acetylene glycol, and 0-30% humectant that includes ethylene glycol or diethylene glycol, i.e. coupling tail solvent. Further, there is disclosed contact lens marked with the ink (paragraphs 2, 13, 32-33, 37, 94-97, and 105).

In light of the above, it is clear that Tucker et al. anticipate the present claims.

12. Claims 1-3, 7-9, and 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Yamazaki et al. (U.S. 2002/0017219).

Yamazaki et al. disclose ink jet ink comprising 0.5-30% pigment such as carbon black, base, in amount of, for instance, 0.1%, 0.5-30% acrylic resin emulsion, i.e. binder, 6-20% coupling tail solvent, i.e. ethylene glycol, not more than 2% anionic or nonionic surfactant such as acetylene glycol, and remainder water (paragraphs 17, 24, 30, 33-34, and 42-45).

While there is no disclosure that the ink is an ophthalmic marking ink as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that "if the body of a claim

fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction". Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.

It is the examiner's position that the preamble does not state any distinct definition of any of the claimed invention's limitations and further that the purpose or intended use, i.e. ophthalmic marking ink, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art ink and further that the prior art structure which is ink identical to that set forth in the present claims is capable of performing the recited purpose or intended use.

In light of the above, it is clear that Yamazaki et al. anticipate the present claims.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35

U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

14. Claims 2, 6, and 7-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Doshi '410 (U.S. 6,315,410) in view of Yui et al. (U.S. 5,948,155)

The disclosure with respect to Doshi '410 in paragraph 9 above is incorporated here by reference.

The difference between Doshi '410 and the present claimed invention is the requirement in the claims of (a) base and (b) specific surfactant.

With respect to difference (a), Yui et al., which is drawn to ink composition, disclose using base such as potassium, sodium, lithium or ammonium hydroxide in order to improve the dispersion stability of the water-insoluble coloring material present in the ink (col.6, lines 59-64).

With respect to difference (b), Doshi '410 discloses the use of nonionic surfactant such as polyoxyalkylene alkyl ether.

Yui et al., which is drawn to ink composition, disclose the use of surfactant such as acetylene alcohol in order to control the surface tension of the ink. Yui et al. also disclose the equivalence and interchangeability of acetylene alcohol with polyoxyethylene alkyl ether

surfactant disclosed by Doshi '410 (col.6, lines 59-64, col.7, lines 17-18, and col.24, lines 26-27).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use base and acetylene alcohol surfactant in the ink of Doshi '410 in order to produce ink with good dispersion stability and desired surface tension, and thereby arrive at the claimed invention.

15. Claims 2, 6, and 7-8 rejected under 35 U.S.C. 103(a) as being unpatentable over Tucker et al. (U.S. 2003/01199430) in view of Yui et al. (U.S. 5,948,155)

The disclosure with respect to Tucker et al. in paragraph 11 above is incorporated here by reference.

The difference between Tucker et al. and the present claimed invention is the requirement in the claims of base.

Yui et al., which is drawn to ink composition, disclose using base such as potassium, sodium, lithium or ammonium hydroxide in order to improve the dispersion stability of the water-insoluble coloring material present in the ink (col.6, lines 59-64).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to use base in the ink of Tucker et al. in order to produce ink with good dispersion stability, and thereby arrive at the claimed invention.

16. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su et al. (U.S. 5,352,245), Doshi '410 (U.S. 6,315,410), or Tucker et al. (U.S. 2003/01199430) any of which in view of Souel et al. (U.S. 6,281,468).

The disclosures with respect to Su et al., Doshi '410, and Tucker et al. in paragraphs 8-9 and 11, respectively, are incorporated here by reference.

The difference between Su et al., Doshi '410, or Tucker et al. and the present claimed invention is the requirement in the claims of (a) cleaning the lens surface with aqueous media and drying before applying ink and (b) treating lens surface with corona discharge.

With respect to difference (a), each of Su et al., Doshi '410, and Tucker et al. disclose applying ink to contact lens using pad printing, however, there is no disclosure in any of the references of first cleaning and drying the contact lens. However, it would have been within the skill level of one of ordinary skill in the art to clean and dry contact lens before applying ink in order to ensure that ink is applied to surface without dirt or moisture and thus ensure that the ink is able to adhere to the contact lens as well as remain adhered.

With respect to difference (b), Souel et al. disclose subjecting contact lens to be marked with corona discharge in order to increase surface energy and thereby improve adherence of the surface to be marked (col.1, lines 54-60 and col.5, lines 18-23).

In light of the above, it therefore would have been obvious to one of ordinary skill in the art to clean the contact lens with aqueous media and dry the contact lens followed by applying corona discharge to the surface of the lens of Su et al., Doshi '410, or Tucker et al. before applying ink in order to produce contact lens wherein the ink is easily applied to the lens and remains firmly adhered, and thereby arrive at the claimed invention.

17. Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki et al. (U.S. 2002/0017219) in view of Valentini et al. (U.S. 2003/0184629).

The disclosure with respect to Yamazaki et al. in paragraph 12 above is incorporated here by reference.

The difference between Yamazaki et al. and the present claimed invention is the requirement in the claims of polyurethane dispersion.

Yamazaki et al. disclose the use of acrylic binder.

Valentini et al., which is drawn to ink, disclose the use of mixture of acrylic binder and polyurethane dispersion in order to improve smearfastness and waterfastness of the ink (paragraphs 2, 35, 118, 179, and Tables 3 and 5).

In light of the motivation for using polyurethane dispersion disclosed by Valentini et al. as described above, it therefore would have been obvious to one of ordinary skill in the art to use polyurethane dispersion in the ink of Yamazaki et al. in order to produce ink with good smearfastness and waterfastness, and thereby arrive at the claimed invention.

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

WO 97/41180 discloses ink for ophthalmic lenses wherein the ink comprises water, binder, dispersant, and colorant, however, the amount of colorant falls outside the scope of the present claims and further, there is no disclosure of solvent as required in all the present claims.


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Phelan et al. (U.S. 2004/0125338) discloses ink for contact lens wherein the inks comprise water, colorant, and binder.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
4/23/05